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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,150	11/26/2003	Yoshifumi Ishihata	K6510.0064/P064	5542
24998	7590	06/25/2007	EXAMINER	
DICKSTEIN SHAPIRO LLP			BANTA, TRAVIS R	
1825 EYE STREET NW			ART UNIT	PAPER NUMBER
Washington, DC 20006-5403			3714	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b><i>Office Action Summary</i></b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/721,150	ISHIHATA ET AL.
<b>Examiner</b>	<b>Art Unit</b>	
	Travis R. Banta	3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 28 February 2007.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-20 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 11/26/2003 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5)  Notice of Informal Patent Application  
6)  Other: \_\_\_\_\_.  
\_\_\_\_\_

## DETAILED ACTION

The Specification, Drawings, and the Oath or Declarations are acceptable as noted on the Office Action Summary sheet included with this Office Action.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention is directed to non-statutory subject matter.

Regarding claims 1-20, Each claim is drawn to "a control program for an action game". Computer programs as defined by MPEP section 2106 are non-statutory subject matter and are therefore not patentable.

Moreover, there is no concrete, tangible, or useful result that is defined by the claims. One might argue that selecting a new attack target is in itself a tangible step, however, in the context of a game, this is merely a manipulation of data. Changing an attack target in a game or video game is merely informing an electronic device of a new development in the user's attack plan. As such, the electronic device manipulates data to move target signifying means from one character to another.

Indeed, the outline of the program involved could be argued to occur in the mind of each player as a game is proceeding. For example, consider the game of Chess. A player knowing the rules of the game, is moving characters in a game space. As the game player operates the game, at least one of the characters becomes an attack

target. A player will decide whether or not a character is selectable as a candidate object qualified to be an attack target if it is in a positional relationship which could be selected as an attack target. The player will decide a selection order to decide which of the pieces among the possibly attackable pieces is the one the player wants to attack. The player will then decide which of the characters to attack. The next attack target will be sequentially changed in response to the player's next move.

This example has satisfied independent claim 1 and nothing tangible has happened. The player has merely analyzed the board, identified attack targets, and mentally selected an order in which the player wishes to attack those targets. Hence, the claims are non-statutory for this reason as well as those identified above regarding the claim being directed to a computer program.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Musteller (US 4,019,745).

Regarding the claim 1, Musteller teaches an optical chess board for playing chess electronically. As the game player operates the game, at least one of the characters becomes an attack target. A player will decide whether or a character is

selectable as a candidate object qualified to be an attack target if it is in a positional relationship which could be selected as an attack target. The player will decide a selection order to decide which of the pieces among the possibly attackable pieces is the one the player wants to attack. The player will then decide which of the characters to attack. The next attack target will be sequentially changed in response to the player's next move (see column 2 line 64 – column 3 line 10).

Regarding claim 2, Musteller teaches conventional chess and chess piece movement. A piece can not attack another piece during a time when the piece fails to satisfy a positional relationship with the attack target. When the piece satisfies the relationship, the opportunity to attack is reset (see column 2 line 64 – column 3 line 10).

Regarding claims 3-6, Musteller inherently teaches a player can not attack a target if the target has become ineffective as a target and a player must rethink his move. When a player is attacked, the pieces are decreased. When a pawn accomplishes each space all the way to the far side of the board, the number of pieces is increased all in response to a player's control and operation of the game. (see column 2 line 64-column 3 line 10). This is inherently taught, as these are conventional chess rules employed by Musteller in the invention.

Regarding claims 7- 15, Musteller inherently teaches a positional relationship between each piece in the game. If the overlapping possible movements intersect, a piece can attack another piece (column 3 lines 27-52). This forms a base point, and a base angle to define a distance and makes attacks possible. A game screen is

provided (see column 3 line 53-56). This is inherently taught, as these are conventional chess rules employed by Musteller in the invention.

Regarding claims 16-18, Musteller inherently teaches the only attackable characters are the ones in the view of the selectable objects (see column 3 line 27-52). That is to say for example, the king in the chess game has a view of 1 space in any direction. A knight has a view of 2 spaces in one direction and then 1 space in the axially different direction. This is inherently taught, as these are conventional chess rules employed by Musteller in the invention.

Regarding claim 19, Musteller teaches an information storage medium (see column 2 lines 59-63)

Regarding claim 20, Musteller teaches an electronic device for executing the program (see column 1 lines 40-53).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis R. Banta whose telephone number is (571) 272-1615. The examiner can normally be reached on Monday-Friday 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bob Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TB

*Ronald Laneau*  
RONALD LANEAU  
PRIMARY EXAMINER

6/21/07